REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 9, 11, 21, 23, 33, 35, 37-39, 41-43 and 45-47 have been amended. Claims 8-12, 20-24 and 32-48 are pending. No new matter has been entered.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Objections

Claim 41 has been amended to overcome the Office Action's objection thereto.

Rejection of the claims

The Office Action rejected claims 11, 23 and 35 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,893,132 ("Huffman").

As amended, claim 11 recites:

> 11. A method performed by a computer system, comprising:
> storing a first version of a paper;
> translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper;
> in response to content within the first version, detecting a reference by the content at a first location within the paper, the detected reference being associated with a second location; and
> in response to the detected reference, forming a link within the second version between the first location and the second location, and the first location being displayable on the display device as part of the likeness and selectable to cause an operation associated with the second location.

As amended, claim 23 recites:

> 23. A system, comprising:
> a computing device for:
> storing a first version of a paper;
> translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper;
> in response to content within the first version, detecting a reference by the content at a first location within the paper, the detected reference being associated with a second location; and
> in response to the detected reference, forming a link within the second version between the first location and the second location, and the first location being displayable on the display device as part of the likeness and selectable to cause an operation associated with the second location.

As amended, claim 35 recites:

> 35. A computer program product, comprising:
> a computer program processable by a computer system for causing the computer system to:
> store a first version of a paper;
> translate the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper;
> in response to content within the first version, detect a reference by the content at a first location within the paper, the detected reference being associated with a second location; and
> in response to the detected reference, form a link within the second version between the first location and the second location, and the first location being displayable on the display device as part of the likeness and selectable to cause an operation associated with the second location; and
> an apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

> *"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain a rejection of claim 11, Huffman must contain all of the above-recited elements in claim 11. However, Huffman fails to teach the combination of elements in claim 11.

For example, as cited in the Office Action, Huffman teaches that "the processor 152 directly converts the text from the book into speech signals for the voice synthesizer 162" (col. 8, lines 1-10). Nevertheless, Huffman's speech signals are ***not*** displayable on a display device as a likeness of the electronic book. Consequently, unlike claim 11, Huffman's conversion of text into speech signals: (a) fails to teach translating a first version of a paper into a second version of the paper, ***the second version being displayable on a display device as a likeness of the paper***; and (b) likewise fails to teach forming a link ***within the second version*** between the first location and the second location, because Huffman fails to teach formation of such a link within the speech signals themselves.

Accordingly, Huffman does not support a rejection of claim 11 under 35 U.S.C. § 102(e). In relation to claims 23 and 35, Huffman is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 11, Huffman is defective in establishing a *prima facie* case of obviousness. For example, as between Huffman and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 11. In fact, Huffman teaches away from such a combination.

For example, at col. 8, line 50-col. 9, line 35, Huffman describes the touchscreen 130 of Fig. 4 as having a first hot spot portion 170, a second hot spot portion 178, a third hot spot portion 180, a fourth hot spot portion 184, and a fifth hot spot portion 186. Nevertheless, as shown in Fig. 4 of Huffman, each of the various "hot spot" portions has a respective ***predetermined*** (e.g., predetermined by a user or other human) size, position, and orientation, irrespective of the electronic book's content. Consequently, Huffman teaches away from a ***computer system*** that: (a) in response to ***content within*** a first version of the electronic book, detects a reference ***by the content*** at a first location within the electronic book (the detected reference being associated with a second location); and (b) in response to the detected reference, forms a "hot spot" link (within a translated second version of the electronic book) between the first location and the second location.

At col. 13, lines 55-60, Huffman describes a dog ear dialog box 302, which is displayed on the touchscreen 130 of Fig. 18. According to Huffman, a "user can immediately go to one of the dog-eared pages on the list 304 by touching a display of a selected page number" (col. 13, lines 58-60). Nevertheless, at col. 13, lines 39-44, Huffman expressly states, "The ***user*** initiates a dog ear command by performing a predetermined user-initiated event. An example of such an event includes a user touching an upper corner position of the touchscreen 130, such as the fifth hot spot portion 186 defined earlier." Consequently, Huffman teaches away from a ***computer system*** that: (a) in response to ***content within*** a first version of the electronic book, detects a reference ***by the content*** at a first location within the electronic book (the detected reference being associated with a second location); and (b) in response to the detected reference, forms a "dog ear" link (within a translated second version of the electronic book) between the first location and the second location.

Clearly, therefore, Huffman fails to teach claim 11, and in fact teaches away from it. Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a *prima facie* case of obviousness has not been met.

In relation to claims 23 and 35, Huffman is likewise defective in establishing a *prima facie* case of obviousness.

Thus, a rejection of claims 11, 23 and 35 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 11, 23 and 35.

Dependent claims 8-10, 12 and 37-40 depend from and further limit claim 11 and therefore are allowable.

Dependent claims 20-22, 24 and 41-44 depend from and further limit claim 23 and therefore are allowable.

Dependent claims 32-34, 36 and 45-48 depend from and further limit claim 35 and therefore are allowable.

An early formal notice of allowance of claims 8-12, 20-24 and 32-48 is requested.

No additional fee is believed due. Nevertheless, to the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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